

### REMARKS

Claims 1-23 and 44-63 are pending in the case. Claims 1-23 were originally filed in the case, claims 24-43 were previously cancelled, and claims 44-63 were previously added. Claims 24-43 were canceled responsive to a restriction requirement. The Office rejected each of claims 1-23 and 44-63 as follows:

- claims 1-5, 7-11, 13-15, 17-22, 44-48, 50-54, 56-58, and 60-63 were rejected as obvious under 35 U.S.C. §103(a) over United States Letters Patent 5,517,414 (“Hrovat”) in view of United States Letters Patent 4,895,257 (“Brandstadter”);
- claims 6, 12, 16, 49, 55, and 59 were rejected as obvious under 35 U.S.C. §103(a) over Hrovat in view of Brandstadter and United States Letters Patent 6,481,801 (“Krueger”); and
- claim 23 was rejected as obvious under 35 U.S.C. §103(a) over Hrovat in view of Brandstadter and United States Letters Patent 5,762,407 (“Stacey et al.”).

Applicant traverses each of the rejections.

Each of the rejections relies on the combination of Hrovat and Brandstadter, which cannot be properly combined. The Office’s justified the combination as follows:

It would have been obvious to one of ordinary skill and creativity in the art at the time the apparatus was made to modify the suspension of Hrovat to rotatably articulate in a plane defined by the pitch of the vehicle as taught by Brandstadter so as to accommodate use of the system on off-road vehicles that commonly use suspensions that articulate in the plane defined by the pitch of the vehicle (background).

(Detailed Action, p. 8, ¶3) However, this reasoning directly contravenes the evidence of record.

More particularly, Brandstadter itself teaches away from using on-road active suspension systems in off-road vehicles:

*In a road vehicle, the dynamic component is primarily due to the acceleration, braking, and cornering inertial forces acting on the vehicle. These forces are smaller than the static force, and the aforescribed parallel arrangement results in a substantial reduction in the energy required to stabilize the vehicle in reaction to these forces.*

*In an off-road vehicle, however, the dynamic component is primarily due to terrain disturbances producing large road wheel motions. The forces associated with these large motions are greater than the static force and the parallel arrangement results in an increase in the energy required to isolate the vehicle in reaction to these motions. Thus, the increased size, weight, and cost of the parallel arrangement is not offset by a comparable reduction in the energy requirements under off-road conditions and, therefore, this type of system is not applicable to off-road vehicles generally and to combat vehicles specifically.*

(col. 2, lines 6-24; emphasis added) Thus, according to Brandstadter, on-road and off-road suspension systems encounter forces differently, and sufficiently differently that on-road suspension systems do not yield sufficient performance for off-road vehicles.

Brandstadter therefore specifically teaches away from using on-road active suspension systems in off-road vehicles. There can be no motivation or suggestion to combine references as a matter of law where one of the references teaches away from the claimed invention. *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984); M.P.E.P. §2145 X D 2. Thus, under law and under Office policy, Hrovat and Brandstadter are not combinable.

Furthermore, it is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. *See, inter alia, In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986). It appears the passage quoted above that the Office essentially believes that Applicant has but taken an on-road

active suspension system and put it in an off-road vehicle. If this is, indeed, the Office's position, then Brandstadter establishes that Applicant's invention is *prima facie* non-obvious.

Thus, on its face, Brandstadter refutes the proposition that it can be properly combined with Hrovat. Each of the rejections relies upon the combination of Hrovat and Brandstadter, and so each of the rejections fails since they are not properly combinable. And, if the Office's position is what it seems, that Applicant's invention as claimed is *prima facie* unobvious over the art of record. Wherefore, Applicant requests that the rejections be withdrawn.

The Examiner is invited to contact the undersigned attorney at (713) 934-4053 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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